

REMARKS

Upon entry of this amendment, claims 19-23, 25-28, 30-34, and 37-39 will be pending. Claims 37-38 are withdrawn. Rejoinder of Claims 37-38 is respectfully requested.

Claim 19 has been amended to recite n is 4. Claims 37 and 38 have been amended to recite methods of treating colon adenocarcinoma, breast adenocarcinoma, ovarian adenocarcinoma, epidermoid adenocarcinoma or prostate adenocarcinoma. Support for this amendment can be found throughout the specification as originally filed as well as in the experimental data provided in the Declaration under 37 C.F.R. 1.132 provided in connection with the Applicants response to the previous office action. Specifically with respect to the data obtained for the following cell lines: HT-29, A2780, KB-3-1, L929, and MCF-7.

Amendment and cancellation of the claims herein is not/are not to be construed as acquiescence to any of the rejections/objections set forth in the instant Office Action and were done solely to expedite prosecution of the application. Applicants hereby reserve the right to pursue the claims as originally filed or similar claims in this or one or more subsequent patent applications.

Claim Rejections – 35 U.S.C. § 112, first paragraph

Claims 19-23, 25-28, 30-34, and 39 are rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to enable compounds wherein n is 2, 3 or 5. The Examiner states that the starting materials and how to make the non-piperidinyl compounds “are not seen but required.”

Without acquiescing to the grounds for the rejection, Claim 19, from which claims 20-23, 25-28, 30-34, and 37-39 depend, has been amended to recite that n is 4. No new matter has been added by these amendments. Applicants believe that this rejection is now moot.

Therefore, Applicants respectfully request that the rejection of the claims under 35 U.S.C. § 112, first paragraph, be reconsidered and withdrawn.

Request for Rejoinder of Method Claims

Claims 37-38 relate to methods of treating a patient comprising one or more compounds of claim 19. As such, method of use claims 37-38 are commensurate in scope with the present compound claims. Since a search for the compounds of claim 19 will necessarily result in all uses of any such compounds, and as Applicants believe that claim 19 is presently in condition for allowance, Applicants respectfully request rejoinder of method of use claims 37-38 in accordance with M.P.E.P. 821.04 and *In re Ochiai*, 71, F.3d 1565 (Fed. Cir. 1995).

With regard to the potential for rejection of claims 37-38 under 35 U.S.C. 112, first paragraph, as described above, without acquiescing to the grounds for the potential rejection claims 37 and 38 have been amended to recite methods of treating colon adenocarcinoma, breast adenocarcinoma, ovarian adenocarcinoma, epidermoid adenocarcinoma or prostate adenocarcinoma. Support for this amendment can be found throughout the specification as originally filed as well as in the experimental data provided in the Declaration under 37 C.F.R. 1.132 provided in connection with the Applicants response to the previous office action. Specifically with respect to the data obtained for the following cell lines: HT-29, A2780, KB-3-1, L929, and MCF-7. As such, Applicants believe amended claims 37-38 fully meet the requirements of 35 U.S.C. 112, first paragraph, and are suitably proper for rejoinder.

CONCLUSION

In view of the amendments and remarks made herein, Applicants submit that the application is in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance are respectfully requested. If a telephone conference with Applicants' representative would be helpful in expediting prosecution of the application, Applicants invite the Examiner to contact the undersigned at the telephone number indicated below.

FEE AUTHORIZATION

Applicants request a one-month extension for filing the within response. The Director is authorized to charge the extension fee and any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to Deposit Account No. 04-1105, under Order No. 62661(52171).

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Respectfully submitted,

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